

REMARKS

Upon entry of the Amendment, Claims 1-11 and 13-23 will be pending in the application.

Claims 1 and 11 are amended to incorporate the subject matter of Claim 12, now canceled.

Claims 13 and 18 are amended to overcome objections to these claims.

Entry of the Amendment along with reconsideration and review of the claims on the merits are respectfully requested.

Formal Matters

Applicants appreciate the Examiner's acknowledgement of Applicants' claim for foreign priority and receipt of certified copies of the priority documents.

Applicants also appreciate the Examiner's consideration of the Information Disclosure Statement filed on June 28, 2004.

Response to Double Patenting Rejection

A. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,819,899 to Miyakawa et al.

B. Claims 1, 4, 8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 17, 16 and 15, respectively, of U.S. Patent No. 6,819,899 to Miyakawa et al.

C. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,819,899 to Miyakawa et al. in view of Nakamura et al. (US 5,753,396).

D. Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,819,899 to Miyakawa et al. in view of Nakamura et al. (US 5,753,396) (*sic* - Tamaoki et al., JP 2002-131973).

E. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,819,899 to Miyakawa et al. in view of Nakamura et al. (US 5,753,396) (*sic* - Tokimatsu et al., JP 11-231692).

F. Claims 11 and 21; 19; 20; and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3; 16; 15; and 22, respectively of U.S. Patent No. 6,819,899 in view of Tokimatsu et al. (JP 11-231692) and Hara (JP 2001-166605).

G. Claims 11 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,819,899 in view of Tokimatsu et al. (JP 11-231692) and Hara (JP 2001-166605).

H. Claims 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/751306 to Miyakawa et al. (see published application US 2004/0265714) in view of Miyakawa et al. (EP 1271251 A1) and Hara (JP 2001-166605). This is a provisional obviousness-type double patenting rejection as the copending application is still under

examination.

I. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,819,899 to Miyakawa et al. in view of Tokimatsu et al. (JP 11-231692), Hara (JP 2001-166605) and Tamaoki et al. (JP 2002-131973).

Applicants respond as follows.

As previously noted, Claims 1 and 11 are amended to incorporate the subject matter of Claim 12, now canceled. Thus, the double patenting rejections described in Paragraphs A-G and I should be considered moot, as each of the independent Claims 1 and 11, as amended by incorporating the subject matter of Claim 12, is not rendered obvious by the given references or combinations thereof, nor are the claims dependent thereon rendered obvious at least for the same reasons.

Regarding the double patenting rejection described in Paragraph H above, Applicants file concurrently herewith a terminal disclaimer over Miyakawa (copending Application No. 10/751,306, which is commonly owned with the present application) in order to overcome the provisional rejection based on a nonstatutory double patenting ground.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the double patenting rejections.

Response to Objection to the Specification

The Examiner asserts that the title of the invention is not descriptive and requires that it be clearly indicative of the invention to which the claims are directed.

Applicants respond as follows.

Applicants have amended the title to: “Image-Forming Apparatus Employing Work Function Relationships”, and submit that the new title is more clearly descriptive of the present invention. Entry of the amended title is respectfully requested.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to the specification.

Response to Claim Objections

Claims 13 and 18 are objected to because of the following informalities.

In Claim 13, line 4, the Examiner points out that "lager" should be changed to "larger".

In Claim 18, lines 5-7, the Examiner states that the direction defined is unclear and suggests changing these lines to "the direction of movement of the latent image holding member is the same as that of the developing device at an area where the latent image holding member is closest to the developing device". The Examiner points out that, as shown in Figures 2 and 3, the latent image holding member rotates in a clockwise direction, and the developing device rotates in a counterclockwise direction.

Applicants have responded as follows.

Applicants have amended Claim 13 to recite “larger” as suggested by the Examiner.

Applicants have amended Claim 18 in the manner suggested by the Examiner.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to Claims 13 and 18.

Response to Claim Rejections - 35 U.S.C. §102 and §103

A. Claims 1, 3, 4 and 7-10 are rejected under 35 U.S.C. §102(b) as assertedly being anticipated by Miyakawa et al. (EP 1271251 Al), for the reasons given in the Office Action.

The Examiner cites Miyakawa et al. EP '251 as disclosing an image-forming apparatus comprising: a latent image holding member on which an electrostatic latent image is to be formed; developing devices having toners of different colors for developing the electrostatic latent image on the latent image holding member to form a toner image; and an intermediate transfer member onto which the thus formed toner image is to be transferred, wherein the intermediate transfer medium has a work function smaller than the work function of the toners according to the present invention.

B. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Miyakawa et al. (EP 1271251 Al) in view of Nakamura et al. (US 5,753,396).

C. Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Miyakawa et al. (EP 1271251 Al) in view of Tamaoki et al. (JP 2002-131973).

D. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Miyakawa et al. (EP 1271251 Al) in view of Tokimatsu et al. (JP 11-231692).

E. Claims 11, 13-16 and 18-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyakawa et al. (EP 1271251 Al) in view of Tokimatsu et al. (JP 11-231692) and Hara (JP 2001-166605).

F. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Miyakawa et al. (EP 1271251 Al) in view of Tokimatsu et al. (JP 11-231692) and Hara (JP 2001-

166605) as applied to claim 11 above, and further in view of Tamaoki et al. (JP 2002-131973).

Applicants respond as follows.

As previously noted, Claims 1 and 11 are amended to incorporate the subject matter of Claim 12. Claim 12 is not included in the anticipation rejection or any of the obviousness rejections. As Applicants have filed a Terminal Disclaimer, dependent Claim 12 should not be under any rejections.¹ Thus, Applicants submit that the subject matter of Claim 12, which is directed to the image-forming apparatus wherein the developing devices for respective colors have been disposed so that the toner to be used first for development has the largest work function among all toners and the other toners are used in descending order of work function, should be allowable subject matter. Since the subject matter of Claim 12 is now incorporated into Claims 1 and 11, Claims 1 and 11 are patentable over the cited art. Furthermore, claims dependent thereon are also patentable for at least the same reasons.

Applicants thus submit that Miyakawa fails to anticipate the present invention as amended and fails to render obvious the present invention when combined with any of the cited secondary references.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the anticipation and obviousness rejections.

Conclusion

¹ Claim 12 was rejected for obviousness-type double patenting over U.S. Application No. 10/751,306 (US 2004/0265714). However, the present invention and US '714 were commonly owned at the time the present invention was made, and Applicants overcome the double patenting rejection by the filing of a Terminal Disclaimer.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 10/762,497

Atty. Docket No. Q79568

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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